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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/507,320	09/10/2004	Hideki Kitano	Q83497	4421
23373	7590	11/09/2007	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			VERDERAME, ANNA L	
			ART UNIT	PAPER NUMBER
			1795	
			MAIL DATE	DELIVERY MODE
			11/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/507,320

Applicant(s)

KITANO ET AL.

Examiner

Anna L. Verderame

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-9 and 25-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-9 and 25-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

The applicant's arguments/amendments, received on 08/30/2007, have been carefully considered. A response is presented below.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, 5-9 and 25-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsuoka et al. JP-11102542 in view of Takeda 6,627,688 and Tanaka 2002/0086143.

Matsuoka et al. teaches a laminate consisting of a release sheet and a second Release sheet which are bonded to each other with a double sided adhesive sheet. A first disc substrate and a second disc substrate (16a and 16b) are prepared. The first release sheet is peeled off from the laminate and the 1st disc substrate 16a is bonded to the exposed adhesive surface of the double-sided adhesive sheet. Then the second release sheet is peeled off from the surface of the double-sided adhesive sheet opposite to the surface to which the 1st disc substrate 16a is bonded and the 2nd disc substrate 16b is bonded to the exposed adhesive surface of the double-sided adhesive

sheet 11(abstract). The use of exfoliation sheets(release sheets) made from polyethylene, polyester, and polypropylene is disclosed at (0018). Benefits of using a double-sided adhesive sheet include reduced distortion and more precision in the thickness of the layer (0039-0041).

Matsuoka does not teach specific adhesive compositions for use in optical disks.

Takeda et al. teaches adhesive compositions for use in articles comprising a metal layer such as **adhesive sheets** and optical disks(1/5-21). One preferred example of an adhesive polymer according to the present invention is an acrylic polymer in which a raw material (A) containing one or more alkyl acrylates and (B) a hydroxyalkyl (meth) acrylate can be prepared. Examples of alkyl acrylates include ethyl-acrylate, and 2-ethylhexyl acrylate. The hydroxyalkyl acrylate includes for example 2-hydroxyethyl acrylate. The proportion of A is usually from 80 to 99% and the proportion of B is usually from 1-20%(6/41-67). In addition to components A and B the other copolymerizable monomer such as **alkyl methacrylate may be used**(7/3-5). The molecular weight of the polymer is in the range of between **10,000 to 100,000**(7/7-11). As the polymerization energy heat or radiation(e.g. ultraviolet ray or electron beam) can be used(7/23-30). The adhesive may be formed on a substrate including those made of polyester, polyvinyl chloride etc. (8/35-45). Example one teaches an adhesive composition comprising butyl acrylate and isobutyl acrylate and a polymerization initiator. The solvent used is ethyl acetate(13/65-14/5).

The examiner notes the composition of formulation I in the applicant's specification at (0228). This composition contains 90% alkyl acrylate including 2-

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ethylhexyl methacrylate and methyl-methacrylate, and contains 10% 2-hydroxyethyl methacrylate.

Tanaka et al. teaches acrylic self-adhesive resins including those obtained by polymerizing (A) at least one of ethyl acrylate, n-hexyl acrylate, or 2-ethylhexyl acrylate and (B) at least one including 2-hydroxyethyl methacrylate. The ratio of A/B is 99.5/0.5 to 80/20(0047). The glass transition temperatures for adhesives according to this application are in the range from -100°C to 50°C (0045). UV absorbers including benzophenone may be added to the self-adhesive resins(0050). Amounts for the UV-absorber are disclosed at (0052). Solvents such as ethyl acetate may be used (0055). Use of solvent mixture of ethyl acetate and toluene is taught at (0100). Thicknesses of the adhesive layer can be in the range of 5 to 80 micrometers(0044).

The examiner notes that the adhesive compositions taught in Tanaka et al and Takeda et al. are substantially similar to one another and also substantially similar to the compositions used by the applicant.

With regard to the applicant's claim that the adhesive composition has a light-transmittance of not less than 70% in the wavelength range of 380-420nm in claim 1 and not less than 80% in claim 3, it is elementary that the mere recitation of newly discovered function or property inherently possessed by things in the prior art. In re swinehart et al., 169 USPQ 226 at 229. The burden is upon the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristics relied upon.

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With respect to the surface roughness values recited in claims 25 and 27 the materials used in the reference (polyester (0034)) are the same as those used by the applicant. The applicant has the burden of distinguishing their invention from that disclosed in the prior art or establishing the criticality of surface roughness and establishing that this characteristic is not present in the prior art.

It would have been obvious to one of ordinary skill in the art to modify the dual sided adhesive taught by Matsuoka et al. by forming the adhesive sheet of an adhesive composition comprising 90% alkyl acrylate and 10 % hydroxylalkyl acrylate dissolved in a solvent consisting of ethyl acetate and toluene based on the combined disclosure of Takeda et al. and Tanaka et al. and further to add a UV absorber such as benzophenone in the amount of between 0.5 and 10% based on the disclosure of Takeda to use UV-absorbers and the disclosure of benzophenone as an acceptable UV-absorber in Tanaka, and with the reasonable expectation of forming an adhesive acceptable for use in optical recording media.

Double Patenting

3. The terminal disclaimer filed by the applicant on 08/30/2007 has been approved. The obviousness-type double patenting rejection presented in the office action mailed on 06/01/2007 is withdrawn.

Conclusion

Response to Arguments

4. The applicant's amendment of claims 1 and 25 to include the limitation that the photo-curable composition comprises "a homopolymer or copolymer derived from alkyl acrylates and/or alkyl methacrylates" is shown to be not novel based on the adhesive compositions taught by Tanaka et al. and Takeda et al.

The applicant argues that a sheet-shaped adhesive was not disclosed by Takehana et al. In the office action mailed on 06/01/2007, Takehana et al. was used for its teaching of specific adhesive compositions. Matsuoka **teaches an adhesive sheet** but does not teach the specific adhesive composition required by the instant claims. Takehana and in this case Tanaka et al and Takeda et al. are used for their disclosure of specific adhesive compositions that meet the limitations of the instant claims.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anna L. Verderame whose telephone number is (571)272-6420. The examiner can normally be reached on M-F 8A-4:30P.

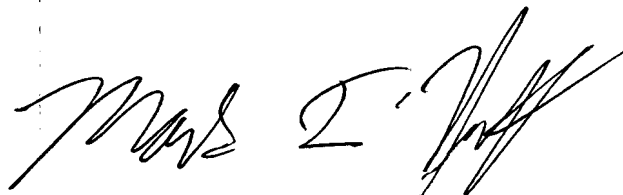
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on (571)272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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